

Ser. No. 10/033,499 (Reis, Gary W.)

2

Claim Rejections - 35 USC § 103(a)

Claims 1-16 remain in this application.

Applicant would like to thank the Examiner for her well researched and considered response. However, Application respectfully submits that the present invention is patentably distinguishable from the prior art on numerous grounds discussed and detailed below.

Applicant respectfully submits US Patent No. 5,156,898, issued to McDonald, hereinafter "McDonald," alone or in combination does not disclose or suggest the type of scorecard folds of the present invention. The scorecard embodiments of the present invention are structurally and functionally distinguishable from the prior art presented by the Examiner whether taken individually or in combination.

With respect to structural differences, the present invention in Claim 1 and 9 claims, inter alia, a golf scorecard in which a series of panels created by a plurality of substantially parallel primary folds that permit panels to be "foldably arranged one atop another." As illustrated in FIG. 2, the upper panels (comprising panels 80B and 82B) and lower panels (comprising panels 88B and 90B) each fold inwardly towards the central panels (comprising panels 84B and 86B). To achieve this configuration, the folds are adapted to permit the user to fold the lower panels 180 degrees inwardly towards the central panels about the first primary fold line (92). Next, the user folds the upper panels 180 degrees inwardly towards the central panels about the second primary fold line 94. If

Ser. No. 10/033,499 (Reis, Gary W.)

3

one were to define the inward folding of the upper panels as being clockwise, the folding of the lower panels would necessarily be counter-clockwise.

The present invention is distinguishable from McDonald. McDonald discloses a scorecard having folds along the edges (12) adapted to cause each panel to fold onto the next adjacent panel. By necessity, all folds are in the same direction, namely all clockwise or all counter-clockwise. The Applicant requests the Examiner consider, for example, any one of the plurality of "intermediate" panels bounded on the left and right sides by vertical fold lines (12), as illustrated in FIG. 4. Assume for the moment that an intermediate panel has a "front" surface facing the user and a "back" surface facing away from the user. To collapse the scorecard, the user must cause one adjacent panel on one side (e.g., to the left) to fold towards the "front" surface, while the other adjacent panel (e.g., to the right) folds towards the "back" surface of the intermediate panel. It is the repetition of the alternate pattern of front and back folds that creates the set of concertina folds that is the thrust of the McDonald patent.

Applicant respectfully submits that not only is the present invention structurally distinguishable, but neither McDonald nor any other reference teaches or suggests modifying the prior art to produce Applicant's invention as it is disclosed in its several embodiments.

With respect to functionality, there are at least two significant differences between Applicant's invention as it is disclosed in its several embodiments and the prior art.

Ser. No. 10/033,499 (Reis, Gary W.)

4

First, the folds (12) in McDonald are configured to allow the user to either fold or unfold in a single operation. In particular, McDonald states in column 1, lines 47-51, that "[the first set of concertina folds] enables the sheet of material to be unfolded in a single movement in which one hand grasps one of the stiff portions and the other hand pulls the other stiff portion away from the first one."

In contrast, the present invention must necessarily be folded or unfolded in a multi-step process. To be folded, the inner surfaces of the lower panels (88B and 90B) are folded inwardly toward the central panels (84B and 86B). After, and only after, the lower panels have been substantially inwardly folded can the upper panels (80B and 82B) be folded inwardly. The tri-fold of the preferred embodiment results in three portions delineated by two substantially parallel folds on each side of the sheet. To collapse the tri-fold of the primary embodiment, the user must therefore serially execute two separate steps. The number of steps necessarily increases with the number of panels. Contrary to McDonald, the present invention cannot be made to fold or unfold in a "single movement."

With respect to the second functional difference, the invention permits the scorecard to retain in its folds an additional insert, a function which McDonald does not and could not support. In particular, the act of folding the upper and lower panels one atop another effectively creates a compartment in which an insert (including instructions or advertising, for example) may be protectively concealed. As illustrated in FIG. 14, the insert (40) may be removably

Ser. No. 10/033,499 (Reis, Gary W.)

5

placed "inside" the scorecard until the user requires or discovers the insert 40. One skilled in the art will appreciate that this insert may be protectively concealed within the scorecard without the need for any means for attaching it to the card. McDonald on the other hand would require a paper clip, adhesive, staple, or binding, for example, to detachably affix the insert to the scorecard.

In addition to the compartment created by primary folds (92,94), the act of folding the scorecard about the secondary fold (96) permits the insert to be pinched within the compartment where it is frictionally retained, thereby minimizing the chance of accidental loss. If and when the user desired to remove the insert from the compartment, he or she need only unfold the scorecard about the secondary fold, at which point the insert may be slidably removed from the compartment openings at the left and right sides of the compartment. There is therefore no need to entirely unfold the card to remove the insert. Nor is there a need to irreversibly separate the insert from the scorecard more generally using the perforated holes, as disclosed in US Design Patent No. 378,358 issued to Campbell, hereinafter "Campbell."

The functionality afforded by the present invention and cited above is not provided for or suggested by McDonald, either alone or in combination with other prior art.

With respect to the assertions of printed matter, Applicant respectfully submits that the configuration of printed matter when placed on the scorecard in the manner claimed,

Ser. No. 10/033,499 (Reis, Gary W.)

6

functionally cooperates with the card. In particular, the location of the promotional, instructive and scorekeeping information as defined in Claims 2-16 permits the user of the card to selectively view predetermined panels of the scorecard without unfolding the card, or with minimal unfold. For example, the placement of promotional, instructive and scorekeeping in Claim 2 permits the user the opportunity to conveniently view that information from the completely folded scorecard, while the invention of Claim 3 provides for the same information to be observed from the scorecard in both the folded and unfolded configurations.

In light of the structural and functional differences between the present invention and prior art, applicant respectfully submits that the present invention as claimed in Claims 1-6, 8-14, and 16 are non-obvious in view of McDonald, and Examiner's rejection traversed.

Regarding Examiner's rejection of Claims 3 and 11 on grounds of obviousness, Applicant asserts that these claims are patently distinguishable from the prior art on grounds that Claims 1 and 9 from which they depend, respectively, are both patently distinguishable from the prior art. These claims, therefore, are in condition for allowance and such action is requested.

Regarding Examiner's rejection of Claims 5 and 13 on grounds of obviousness over McDonald and US Patent No. 5,013,070 issued to Maude, Sr., hereinafter "Maude, Sr.," Applicant asserts that these claims are patently distinguishable from the prior art on grounds that Claims 1 and 9 from which they

Ser. No. 10/033,499 (Reis, Gary W.)

7

depend, respectively, are both patently distinguishable from the prior art. These claims, therefore, are in condition for allowance and such action is requested.

Regarding Examiner's rejection of Claims 6 and 14 on grounds of obviousness, Applicant asserts that these claims are patently distinguishable from the prior art on grounds that Claims 1 and 9 from which they depend, respectively, are both patently distinguishable from the prior art. These claims, therefore, are in condition for allowance and such action is requested.

Regarding Examiner's rejection of Claims 8 and 16 on grounds of obviousness, Applicant asserts that these claims are patently distinguishable from the prior art on grounds that Claims 1 and 9 from which they depend, respectively, are both patently distinguishable from the prior art. These claims, therefore, are in condition for allowance and such action is requested.

Regarding Examiner's rejection of Claims 7 and 15 on grounds of obviousness over Maude, Sr., in view of McDonald, Applicant asserts that these claims are patently distinguishable from the prior art on grounds that Claims 1 and 9 from which they depend, respectively, are both patently distinguishable from the prior art. These claims, therefore, are in condition for allowance and such action is requested. In addition, Applicant respectfully refutes Examiner's assertion that the scorecard in Campbell "[i]nherently" retains the panel once "it is [det]ached to prevent littering..." Applicant respectfully asserts that any attempt by Campbell to retain

Ser. No. 10/033,499 (Reis, Gary W.)

8

the detached panel would necessarily fail since there is no means or suggestion to modify the scorecard to protectively conceal the card in a compartment, or to frictionally retain the detached panel by folding the scorecard on to that which the present application describes as a separate insert.

Applicant asserts that Claims 1-16 are patentably distinguishable from the prior art on grounds that the structural and functional attributes are not disclosed in any combination of prior art references, nor any suggestion to modify those references to produce the present invention.

If, however, any questions remain in view of his communication, the Examiner is encouraged to telephone the undersigned so that a prompt disposition of this application is achieved. In the alternative, Examiner is encouraged to suggest to Applicant amendments the application to bring application in to condition for allowance.

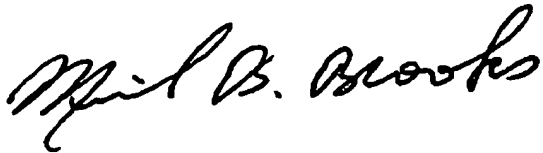
While the applicant anticipates that the total fee for this transaction to be \$0, authorization is hereby given to charge any additional fees, and credit any overcharges pertaining to the prosecution of this matter to Deposit Account No. 02-3979.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Ser. No. 10/033,499 (Reis, Gary W.)

9

Respectfully submitted,

A handwritten signature in cursive script that reads "Michael B. Brooks".

Dr. Michael B. Brooks, Esq.  
Registration Number 39,921

Telephone No. (818) 225-2920  
FAX (818) 225-1569

Law Offices of Brooks and Fillbach  
5010 N. Pkwy Calabasas, Suite 104  
Calabasas, CA 91302-3913